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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,892	10/26/2001	Howard E. Preissman	PX-03-2	8727
21394	7590	02/04/2008	EXAMINER	
ARTHROCARE CORPORATION			PHILOGENE, PEDRO	
7500 Rialto Boulevard			ART UNIT	PAPER NUMBER
Building Two, Suite 100			3733	
Austin, TX 78735-8532			NOTIFICATION DATE	DELIVERY MODE
			02/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[intel\\_prop@arthrocare.com](mailto:intel_prop@arthrocare.com)

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/039,892	PREISSMAN, HOWARD E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 October 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,15-23,25-27,40-42 and 52-71 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,15-23,25-27,40-42 and 52-71 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No: \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date 10/31/07.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 15-18, 40-42, 52-54, 63-67, 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum (4,929,238).

With respect to the above claims Baum discloses a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising a first column (12) having inner wall, an outer wall, a first end and second end having an orifice for delivering implant material therethrough, and an intermediate section, as best seen in figs.5,6, between the first an second end, the first column further comprising an introduction section ( 16) commencing at the first end and adapted to hold the implant material, the introduction section having a different size than the intermediate section;

as best seen in FIGS.1-2,5-6, a second column (34), the second column being drivable with respect to the first column to generate a pressure within the first column; and a handle (42) integrally attached to the second column , the introduction section is sized to facilitate purging of air trapped in the implant material; at least one O-ring (40,54) mounted to an end portion of the second column (12) and interfacing with the inner wall of the second column (12); wherein the second column comprises a wall which is drivably engageable with one of the inner and outer walls; threading (56) on at least a portion of the inner wall of the first column , wherein the wall of the second column (34) is an external wall comprising threading engageable with the threading (9) on at least a portion of the inner wall, as set forth in column 8, lines 5-10, wherein the first column comprises a removable section (16, 30,32) adapted to be removed from the first column for drivingly engaging the first and second columns.

It is noted that Braum did not teach that the section is separable form the first column; as claimed by applicant. However, to make separable thereby removable two component that were integral would have been obvious to one having ordinary skill in the art, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179. Further, as to the functional language "for drivably engaging said first and second columns" the device of Braum is fully capable of performing the function "for slidably engaging said first and second columns" after the removal or separable of the removable section (30,32).

As to claims 40-42, 67-71, the applicator of Baum is capable of generating such pressures, as claimed, since the structure of Baum is fully functionally identical to the applicator as claimed.

Claims 20-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum (4,929,238) in view of Perler (4,863,072).

With respect to the above claims, it is noted that Baum teaches all the limitations, Except for a threading covering only a portion of the second column and an end portion of the second portion relatively smooth and wherein the smooth end portion comprises a reduced diameter section having an outside diameter less than an inside diameter of the threads on the inner wall, and an enlarged section which closely fits with the substantially smooth inner wall to form pressure seal therewith; as claimed by applicant. However, in a similar art, Perler evidences the use of an applicator with such characteristics, as claimed by applicant, to allow the applicator to operate conveniently using one hand.

Therefore, given the teaching of Perler, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate those structures in the device of Baum, as taught by Perler to allow the applicator to operate conveniently using one hand.

Claims 19, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum (4,929,238) in view of Phillips (4,032,118).

With respect to claims 19, 68, it is noted that Eykman teaches all the limitations, except for the at least one sealing element comprises a Teflon Wrap, as claimed by

applicant. However, in a similar art, Phillips teaches a sealing means with Teflon wrap to enhance the seal between two components.

Therefore, given the teaching of Phillips, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the Teflon wrap of Phillips to enhance the seal between the first and the second columns.

***Response to Amendment***

Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive. Applicant's argument that Baum did not teach of a "removable section" is not persuasive, since Braum discloses two removable or separable section (16, 30, 32). The part (16) is removable from the first column and part (30, 32) is integrally formed with the first column. However, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
January 28, 2008

